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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,375	12/19/2000	Samuel N. Zellner	00398; AT1-112	4937

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AT&T Legal Department - Moazzam
Attn: Patent Docketing
Room 2A-207
One AT&T Way
Bedminster, NJ 07921

EXAMINER

DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
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3622

MAIL DATE	DELIVERY MODE
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12/17/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/740,375	Applicant(s) ZELLNER ET AL.	
	Examiner Arthur Duran	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 21-30 have been examined.

Response to Amendment

The Amendment filed 4/5/10 on is sufficient to overcome the prior rejection.

However, a new 103 rejection has been made.

Examiner notes that the BPAI fully Affirmed the rejection of this case on 2/5/10. Hence, the prior 103 rejections of the claims dated 4/19/2007 is affirmed as properly rejected. However, Applicant filed an RCE with claim amendments on 4/5/10.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/5/10 has been entered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 21, and its dependent claims, is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent a method claim must (1) be tied to a particular machine or apparatus (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or

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materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. To correct this issue, the independent claim could be amended such that at least one significant feature (not just data gathering or outputting) of the body of the claims actively uses a technological apparatus (computer, server, processor, etc).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendrey (2002/0102993) in view of Goldhaber (5,794,210).

Claim 21, 26: Hendrey discloses:

Sending first information about a location of the user to a content provider that provides web content to the wireless communication device (Fig. 1; Fig. 2; Paragraphs [5, 53])

Sending an indication to the content provider when the location is continuously changing (Fig. 1; [38, 41]);

Searching a database of location specific advertisements and selecting a location specific advertisement relevant to the user (Fig. 1; [32, 33, 34]),

tracking a first one of a plurality of location-specific advertisements that is associated with the location of the user and tracking that the user is at a stable location that is not continuously changing ([45, 47, 48]).

Hendrey does not explicitly disclose that the advertisements are sent when the user's location is stable. However, Hendrey discloses tracking the user being both moving and stable (see above citations), that particular indications concerning advertisements can be made when the user's location is stable at certain areas ([47]), that the various features and embodiments of the Hendrey disclosure can be utilized for targeting advertisements ([53]), that there are many variations and factors for targeting a user ([32, 33, 34, 58]) and that there are many possible variations of the Hendrey disclosure ([66]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the information in Hendrey's Fig. 1, including whether the user is moving or the location is stable, can be utilized for targeting the user. One would have been motivated to do this in order to better target the user with items of interest. Also, one would have been motivated to do this in order to better target users who are passing near stores or in buildings nearby stores or are proximate to stores and also to better utilize the time and location information for targeting users and for determining whether to send advertising and repeat advertising to users or not.

In regards to claim 26, Hendrey further discloses utilizing a variety of position determining methods or technologies and also that user location information can be sent periodically ([44, 47]). Notice that the location is monitored over a period of time. Hence, the location is not continually monitored but monitored at different periods in

time and, hence, periodically. Also, the utilization of different location determining methods or technologies allows to Hendrey to continually monitor location information, monitor location with very short (seconds or microseconds) periodical feedback of user location, or with longer periodical feedback of user location.

In further reference to independent claim 1, as noted on 6/19/2007, the prior art Hendrey renders obvious:

- sending first information about a location of the user to a content provider that provides web content to the wireless communication device (Figure 1);

- sending an indication to the content provider when the location is continuously changing (Figure 1; [47, 48]);

- searching a first database containing a plurality of location-specific advertisements (Figure 1);

- selecting a first one of the plurality of location-specific advertisements that is associated with the location of the user and is desired to be sent to the user at a stable location that is not continuously changing (Figure 1; [47, 48]); and

- sending the first one of the plurality of location-specific advertisements to the wireless communication device over a communication network when the location is stable and not continuously changing (Figure 1; [47,48]).

Additionally, on 4/5/10, Applicant added to the independent claims, “wherein the user enters a code on the wireless communication device to activate and deactivate an identity-blocking option, the identity-blocking option to allow or prevent dissemination of an identity of the user to the content provider”.

Hendrey does not explicitly disclose wherein the user enters a code on the wireless communication device to activate and deactivate an identity-blocking option, the identity-blocking option to allow or prevent dissemination of an identity of the user to the content provider.

However, as noted above and affirmed by the BPAI on 2/5/10, Hendrey discloses wireless communications and wireless communications device. Hendrey does not explicitly disclose the user enters a code on the device to activate and deactivate an identity-blocking option, the identity-blocking option to allow or prevent dissemination of an identity of the user to the content provider. However, Goldhaber discloses activating and deactivating an identity-blocking option, the identity-blocking option to allow or prevent dissemination of an identity of the user to the content provider (6:61-7:7; 1:45-13:10; 6:55-61). Goldhaber further discloses the user logging in before being able to perform the user functions of providing or not providing identity information (Fig. 13, item 300; Fig. 13; Fig. 12, item 206; 7:27-31). The logging in with a passcode or password functions as the user enters a code on the device. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Goldhaber's user entering a code to activate and deactivate identity sharing to Hendrey's user profile ([32, 37]; above citations). One would have been motivated to do this in order to better allow user privacy and confidentiality (Goldhaber, 12:45-65).

Claim 22, 23, 27-30: Hendrey further discloses targeting users based parameters, filters, preferences, and profiles ([32, 35, 37]) and hiding certain information about users ([3]).

Hendrey does not explicitly disclose not transmitting an indication of the identity of the user.

Goldhaber further discloses targeting users with content based on geographic areas (col 2, lines 27-35; col 15, lines 15-21) and that user geographic area information is known (col 13, lines 5-11).

Goldhaber discloses profiling a user, targeting content or advertising to a user based on known user information, maintaining user privacy, that user's can release user identifying information if the user so chooses (Abstract, second half; col 6, lines 22-45; col 7, lines 61-67; col 14, lines 10-17).

Goldhaber further discloses obtaining second information about the identity of the user for a fee (col 6, line 64-col 7, line 5; col 17, lines 20-26; col 14, lines 7-10).

Goldhaber further discloses the user indicating preferences for content to be received (Fig. 7; Fig. 10).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Goldhaber's user being able to control the user's profile to Hendrey's targeting a user based on a user profile. One would have been motivated to do this in order to better send content of interest to the user.

Claims 24, 25: In regards to claims 24, 25, Hendrey discloses that the user can be tracked as to being home or at work and that this indicates information relative to advertisements ([47]) and that the user can be targeted based on profile or preference or other information (see citations in preceding claims).

Hendrey does not explicitly disclose that the user can indicated geographic areas to receive or not receive content.

However, Goldhaber discloses that the user can indicate a criteria that is to be utilized for delivering content and/or a criteria that is to be used to prevent certain content from being delivered (Fig. 10, item 124; col 6, lines 45-61). Notice that the profile includes items to send and/or not to send and that the user can edit the profile at any time and in any manner.

Goldhaber further discloses that different servers can serve different geographic areas as well as a variety of other interest areas (col 15, lines 17-31) and that the user can indicate as interested or not interested the different interest areas of the different servers (Fig. 10).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Goldhaber's indicating whether to receive content or not based on different criteria and geographic area as a criteria to Hendrey's particular location relative advertisements and targeting a user based on a variety of criteria. One would have been motivated to do this in order to better present content of interest to the user.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. Note the addition of Goldhaber to the 103 rejection above. Also, Examiner notes the following.

Examiner notes that the BPAI Affirmed the rejection of this case on 2/5/10. Hence, the prior 103 rejections of the claims dated 4/19/2007 are affirmed as properly rejected. However, Applicant filed an RCE with claim amendments on 4/5/10.

Additionally, on 4/5/10, Applicant added to the independent claims, “wherein the user enters a code on the wireless communication device to activate and deactivate an identity-blocking option, the identity-blocking option to allow or prevent dissemination of an identity of the user to the content provider”.

Also, Applicant’s Remarks dated 4/5/10 address these newly added features.

Hendrey does not explicitly disclose wherein the user enters a code on the wireless communication device to activate and deactivate an identity-blocking option, the identity-blocking option to allow or prevent dissemination of an identity of the user to the content provider.

However, as noted above and affirmed by the BPAI on 2/5/10, Hendrey discloses wireless communications and wireless communications device. Hendrey does not explicitly disclose the user enters a code on the device to activate and deactivate an identity-blocking option, the identity-blocking option to allow or prevent dissemination of an identity of the user to the content provider. However, Goldhaber discloses activating and deactivating an identity-blocking option, the identity-blocking option to allow or prevent dissemination of an identity of the user to the content provider (6:61-7:7; 1:45-13:10; 6:55-61). Goldhaber further discloses the user logging in before being able to perform the user functions of providing or not providing identity information (Fig. 13, item 300; Fig. 13; Fig. 12, item 206; 7:27-31). The logging in with a passcode or

password functions as the user enters a code on the device. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Goldhaber's user entering a code to activate and deactivate identity sharing to Hendrey's user profile ([32, 37]; above citations). One would have been motivated to do this in order to better allow user privacy and confidentiality (Goldhaber, 12:45-65).

Hence, the prior art combination renders obvious the claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571)272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Arthur Duran/
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